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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,118	08/08/2003	Brian Dorricott	28489/39573	3822
4743	7590	02/03/2009	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			CHEEMA, UMAR	
233 SOUTH WACKER DRIVE			ART UNIT	PAPER NUMBER
6300 SEARS TOWER			2444	
CHICAGO, IL 60606-6357			MAIL DATE	DELIVERY MODE
			02/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/637,118	DORRICOTT, BRIAN
Examiner	Art Unit	
UMAR CHEEMA	2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 April 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 11-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 11-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 May 2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. 01/30/2009.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is response to the Amendment field on 04/28/2008. Claims 1-5, and 11-22 are pending with claims 1, 21 and 22 being the independent claims. Claims 1, 21 and 22 have been amended.
2. Applicant's arguments, see remarks, filed on 04/28/2008, with respect to Specification have been fully considered and are persuasive. The Objection of specification has been withdrawn.
3. Applicant's argument, see remarks, filed on 04/28/2008, with respect to claims 21-22 rejection under § 101 have been fully considered and are persuasive. The § 101 rejection to claims 21-22 has been withdrawn.

Response to Arguments

4. Applicant's arguments with respect to claims 1-5 and 11-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-5, 11-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux et al (Giroux) (US 6,782,003) in view of Greenspan et al (Greenspan) (US 6,850,484).

6. Regarding **claim 1**, Giroux discloses a method of transferring users' email accounts (see col. 5, lines 14-16; transferring an email account from one ASP to another) from a source server to a destination server (see abstract; replicating data from source to destination), the method comprising: setting up the destination server to act as a gateway for transferring e-mail connections intended for the source server, wherein each e-mail account residing on the source server has associated log on details for accessing the e-mail account (see figures 1-2 and the text related; col. 2, lines 27-63, col. 4, lines 9-40); and when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the first time, setting up the destination server to collect the associated log on details entered by the user as the user logs on for the first time (see col. 10, lines 44-50; automatically log; figures 4-5 and the related text) and to initiate the transfer of the user's mail folder and its contents from the source server to the destination server (see fig. 4b(450), col. 6, lines 57-63).

7. Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said setting up destination server to act as a gateway and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the same field of endeavor Greenspan discloses the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (see abstract; col. 2, lines 55-60; a request for information found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server).

8. Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. Motivation for doing so would have been because gateway is a common protocol used for a software or hardware communications.

9. Regarding **claim 2**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 1, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).

10. Regarding **claim 3**, Giroux discloses a method as claimed in claim 2, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).
11. Regarding **claims 4-5**, the combination of Giroux and Greenspan disclose a method as claimed in claim 1, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 4, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).
12. Regarding **claims 6-10**, (Cancelled).
13. Regarding **claim 11**, Giroux discloses a method as claimed in claim 1, further comprising initiating the transfer of the user's mail folder when each user logs on for the first time before the destination server services the user (see col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).
14. Regarding **claim 12**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 11, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).
15. Regarding **claim 13**, Giroux discloses a method as claimed in claim 12, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).

16. Regarding **claims 14-15**, the combination of Giroux and Greenspan disclose a method as claimed in claim 11, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 14, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).

17. Regarding **claim 16**, Giroux discloses a method as claimed in claim 1, further comprising: causing the destination server to pass the e-mail connection through to the source server when each user logs on for the first time; and transferring the user's mail folder once the user has logged off (see col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

18. Regarding **claim 17**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 16, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).

19. Regarding **claim 18**, Giroux discloses a method as claimed in claim 17, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).

20. Regarding **claims 19-20**, the combination of Giroux and Greenspan disclose a method as claimed in claim 16, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3,

lines 55-60); and a method as claimed in claim 19, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).

21. Regarding **claim 21**, Giroux discloses an apparatus for transferring users' e-mail accounts (see col. 5, lines 14-16; transferring an email account from one ASP to another) from a source server to a destination server (see abstract; replicating data from source to destination), the apparatus comprising: a source server on which is set up the e-mail accounts, each e-mail account having associated log on details (see col. 3, lines 30-35; col. 5, lines 51-55; account identification and password) ; and a destination server arranged to receive e-mail accounts as they are transferred from the source server (see abstract, col. 3, lines 30-35), arranged as a gateway transferring e-mail connections to the source server, and further arranged such that, when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the first time, it collects the associated log on details entered by the user as the user logs on for the first time (see col. 10, lines 44-50; automatically log) and initiates the transfer of the user's mail folder and its contents from the source server to the destination server (see fig. 4b(450), col. 6, lines 57-63, figures 1-2 and the text related; col. 2, lines 27-63, col. 4, lines 9-40).

22. Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said gateway transferring e-mail connections and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the

same field of endeavor Greenspan discloses a system manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers, and the stream manager is linked to a packet network, such as the internet (see abstract; col. 2, lines 55-60; a request for information found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server).

23. Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. Motivation for doing so would have been because gateway is a common protocol used for a software or hardware communications.

24. Regarding **claim 22**, Giroux discloses a computer readable medium having computer executable instructions for performing a method of (see col. 7, Software Architecture) transferring users' e-mail accounts from a source server to a destination server (see col. 5, lines 14-16; transferring an email account from one ASP to another), each e-mail account having associated log on details, the computer readable medium comprising; computer executable instructions for causing the destination server to act as a gateway transferring e-mail connections to the source server (see abstract, fig. 4a-b, col. 7, lines 10-13; transferring email accounts), and, when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the

first time, for causing the destination server to collect the associated log on details entered by the user as the user logs on for the first time (see col. 10, lines 44-50; automatically log; figures 4-5 and the related text) and to initiate the transfer of the user's mail folder and its contents from the source server to the destination server (see fig. 4b(450), col. 6, lines 57-63; figures 1-2 and the text related; col. 2, lines 27-63, col. 4, lines 9-40).

25. Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said setting up destination server to act as a gateway and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the same field of endeavor Greenspan discloses the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (see abstract; col. 2, lines 55-60; a request for information found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server).

26. Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. Motivation for doing so would have been because gateway is a common protocol used in any software or hardware communications.

Response to Arguments

27. Applicant's arguments filed April 28, 2008 with respect to claims 1-5 and 11-22 have been fully considered but they are not persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicant's main point of contention. Applicant's arguments include:

A. Regarding claims 1-5 and 11-22, Applicant argues, see remarks, filed on 04/28/2008, none of claims 1-5 or 11-22 are rendered unpatentable over Giroux et al in view of Greenspan et al, because neither Giroux et al. nor Greenspan et al. disclose "collecting log on details entered by the user as the user logs on via the destination server for the first time and initiating the transfer of the user's mail folder and its contents from the source server to the destination server and logging on via a destination server using the log on details of the source server in order to initiate the transfer."

As for Point A, it is Examiner's position that Giroux and Greenspan do disclose "collecting log on details entered by the user as the user logs on via the destination server for the first time and initiating the transfer of the user's mail folder and its contents from the source server to the destination server (see Giroux: col. 10, lines 44-50; automatically log; figures 4-5 and the related text) and initiating the transfer of the user's mail folder and its contents from the source server to the destination server and logging on via a destination server using the log on details of the source server in order to initiate the transfer (see fig. 4b(450), col. 6, lines 57-63, figures 1-2 and the text related; col. 2, lines 27-63, col. 4, lines 9-40; see Greenspan: col. 2, lines 60-67, col. 3,

lines 1-5; IP addresses associated with user's server and destination server; see col. 3, lines 2-5; the destination server may respond automatically, may store the received message, or may forward the message). Thus it is Examiners position that the 35 U.S.C 103(a) rejection is proper.

Examiner's Note: Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./
Examiner, Art Unit 2444

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SPE, AU2444